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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,669	06/20/2003	Clifford A. Behrens	1241_1	5687

9941	7590	02/08/2005

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EXAMINER
RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/600,669	BEHRENS ET AL.
	Examiner	Art Unit	
	Rob Rhode	3625	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1 and 2_ is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) _1 and 2_ is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on _20 June 2003_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All b) ☐ Some * c) ☐ None of:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____.
      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

The lengthy specification has not been checked to the extent necessary to

determine the presence of all possible minor errors. Applicant's cooperation is

requested in correcting any errors of which applicant may become aware in the

specification.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11
F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ
645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In
re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d
528, 163 USPQ 644 (CCPA 1969).
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be
used to overcome an actual or provisional rejection based on a nonstatutory double
patenting ground provided the conflicting application or patent is shown to be commonly
owned with this application. See 37 CFR 1.130(b).
Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).

Claims 1 - 2 are provisionally rejected under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over claims 1-18 of US

Patent 6,615,208. Although the conflicting claims are not identical, they are not

patentably distinct from each other because they address recommending textual items

using a latent semantic algorithm.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

In Claims 1 - 2, the claimed invention is directed to non-statutory subject matter. The claim is directed to a process that does nothing more than manipulate an abstract idea. There is no practical application in the technological arts. See In re Musgrave, 167 USPQ 280 (CCPA 1970) and In re Johnston, 183 USPQ 172 (CCPA 1974). For example in claim 1, the invention in the body of the claim does not recite the use of nor incorporate any technology in carrying out the recited method steps and therefore is not statutory. If the invention in the body of the claim is not tied to the technological arts, environment or machine, the claim is not statutory. See Ex parte Bowman, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) [Unpublished] and note MPEP 2106 IV 2(b). While Bowman is not precedential, it has been cited for its analysis.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 – 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Linden (US 6,266,649 B1) in view of Herz (US 2001/0014868 A1).

Regarding claim 1, Linden teaches a method for automatically recommending textual

items stored in a database to a user of a computer-implemented service, the method

comprising the steps of

storing selections of textual items entered by the user (Abstract and Figure 7),

whenever a new item is added to the database, applying a filter to the textual items,

including the new item, and the stored user selections to establish a conceptual

similarity among the textual items (see at least Col 2, lines 61 – 67 and Col 3, lines 1 –

6), and

alerting the user about the new item whenever the conceptual similarity between the

new item and stored selections is within a prescribed value with reference to the

conceptual similarity (see at least Col 5, lines 31 – 56 and Figure 7). Please note that

Linden does not disclose a latent semantic algorithm. However, Linden does disclose a

method for automatically recommending items conceptually similar to the items stored

in a database of previous purchases as well as current stored items in the shopping cart

(i.e. database). Thereby, Linden results are equivalent of recommending textual items to

the consumer based on their conceptual similarity.

While Linden discloses method for automatically recommending items stored in a

database of previous purchases and current stored items in the shopping cart as well as

establishing a conceptual similarity among the textual items, the reference does not

disclose applying a latent semantic algorithm.

However and in the same area of recommending textual items in an online shopping

environment, Herz teaches applying a latent semantic index/algorithm to establish a

conceptual similarity among textual items (see at least Abstract and Para 0140).

It would have been obvious to one of ordinary skill in the art to have provided the

method of Linden with the method of Herz to have enabled a method a method for

automatically recommending textual items stored in a database to a user of a computer-

implemented service, the method comprising the steps of storing selections of textual

items entered by the user, whenever a new item is added to the database, applying a

latent semantic algorithm to the textual items, including the new item, and the stored

user selections to establish a conceptual similarity among the textual items, and

alerting the user about the new item whenever the conceptual similarity between the

new item and stored selections is within a prescribed value with reference to

the conceptual similarity. Linden discloses a method for automatically recommending

textual items stored in a database to a user of a computer-implemented service, the

method comprising the steps of storing selections of textual items entered by the user,

whenever a new item is added to the database, applying a filter to the textual items,

including the new item, and the stored user selections to establish a conceptual

similarity among the textual items, and alerting the user about the new item whenever

the conceptual similarity between the new item and stored selections is within a

prescribed value with reference to the conceptual similarity (Abstract and Figure 7).

Herz discloses a method of applying a latent semantic index/algorithm to establish a

conceptual similarity among textual items (see at least Abstract and Para 0140). In this

regard, one of ordinary skill in the art would have been motivated to extend the method

of Linden with a method for applying a latent semantic index/algorithm to establish a

conceptual similarity among textual items. In this manner, the search can include

additional text such as summaries or abstracts of the items and thereby enhance the

relevancy of the recommendations.

Regarding claim 2, the Examiner takes Official Notice that a methods of alerting such as

wherein the step of alerting includes the step of transmitting electronic mail to the user

identifying the new item were old and well known at the time of the applicant's invention.

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. The prior art is Aggarwal (US 6,349,309 B1), which discloses

latent semantic indexing/algorithm and Dawson (US 2003/0208407 A1), which discloses

email alerting.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **(703) 305-8230**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(703) 308-1344**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

(703) 872-9306   [Official communications; including

After Final communications labeled

"Box AF"]

(703) 746-7418 [Informal/Draft communications, labeled

"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.
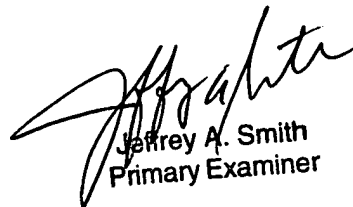
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Business Center (EBC) at 866-217-9197 (toll-free).

RER

Jeffrey A. Smith
Primary Examiner